UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,729	06/26/2003	Philip M. Donian	0054-011P1	5831

40972 7590 02/01/2010
HENNEMAN & ASSOCIATES, PLC
70 N. MAIN ST.
THREE RIVERS, MI 49093

EXAMINER	
RETTA, YEHDEGA	
ART UNIT	PAPER NUMBER
3622	
MAIL DATE	DELIVERY MODE
02/01/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/606,729	DONIAN ET AL.	
	Examiner	Art Unit	
	Yehdega Retta	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 November 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-137* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-137* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This office action is in response to Request for Continued Examination filed November 14, 2009. Applicant amended claims 1, 20, 51, 62, 81, 102, 104, 107 and 117 and added claims 123-137. Claims 1-137 are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 102 and 103 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 102, in the preamble, recites a system claim which can be equated to that of interconnected devices defined by physical structural elements and corresponding functions. However the body of claim recites a communication interface, a user interface, a media player and means for allowing user to re-sequence the presentation and means for altering the presentation, which are interpreted to mean software or modules which do not have a physical structure. The Supreme Court has defined the term "machine" as "a concrete thing, consisting of parts, or of certain devices and combination of devices." *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863). This "includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result." *Corning v. Burden*, 56 U.S. 252, 267 (1854).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 now recites altering, in the media player, presentation of the content of said at least one media file responsive to input from said user. The claim recites receiving at least **one** ad file and at least **one** media file and presenting the stored media file content and the ad file content to said user by *sequencing the media file content and the ad file content in said media player*. Does applicant mean that the sequencing of the presentation is altered or the content is altered? Also does it mean that the ad is presented not at the end of the one media file, but in the middle of presenting the one media file?

Claim 62 is also rejected for the same reason stated in claim 1.

Claim 1 recites the limitation "said stored media file content" and "said stored ad file content". There is insufficient antecedent basis for this limitation in the claim. Claim 1 recites "receiving media file" and "receiving ad file".

Claim 62 is also rejected for the same reason stated above.

Claim 51 recites the limitation "said step of receiving a copy of media file". There is insufficient antecedent basis for this limitation in the claim. Claim 50 now recites "receiving said media file".

Claim 81 recites the limitation "to present the content of said media files", "the content of said ad files", "presentation of said content of said ad files" and "said contents of said media

files". There is insufficient antecedent basis for this limitation in the claim. The claim 1 recites receive "media files" and receive "ad files".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 9-14, 17-28, 30-38, 41, 44-67, 70-85, 89-111 and 114-116 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Knepper et al. (2001/0042249).

Regarding claims 1, 62, 81, 102, 103, Knepper teaches receiving at least one ad file; *storing said at lease one ad file in electronic device;* receiving input indicative of a user's selection of at least one media file; receiving a media file *separately from the ad file; storing said media file in the electronic device* and presenting said *stored* media file content and said *stored* ad file content to said user *sequencing said stored media file content and stored ad file content in said media player* (see [0008]-[0014], [0029], [0030], [0041]). Knepper teaches *altering presentation of said content and basing the presentation of said ad file content at least in part on an amount of the said media file content actually presented to the said user.* Knepper teaches the client application (at block 805) determines whether the download list contains instruction for including an advertisement in a clip of the episode, if not the client application proceeds to download the first non-advertisement media file for the episode and if an instruction

is present in the download list …a user begins play of the episode … typically, a single clip would have an advertisement at its beginning, at its end, both or not all (see [0087]-[0088]. Knepper also teaches the server sending instructions indicating which advertisement media files from among the pre-cached advertisement media files to insert into the entertainment media file at run time, how many advertisement media files to insert, and where to insert them; the instruction file need not specify exactly which advertisement media files to insert; rather, the instruction file can allow the client application to make its own random or pseudo-random selection, subject to any positive and negative associations, for playing back with the entertainment media file (see [0041]). Knepper also teaches shows that are a series of video clips, the sequence of events relating to the arrangement of the various files prior to playback is particular and is dictated by the instruction set or text file; the text file lists the order of the show clips and contains the instruction sets surrounding each of the show clips; upon request of a show or an episode by the user from the server, the text file arrives in the application first; the software organizes the list and begins calling out for the files that it needs to assemble each clip and, then, to assemble the clips to form an episode of a show (see [0046]).

Regarding claims 2, 3, 63, 64, 82 and 83, Knepper teaches receiving another ad file; and re-presenting said media file content to said user with said another ad file content; receiving a plurality of ad files; and said step of presenting said ad to said user includes selecting said ad file from said plurality of ad files (see [0029], [0036], [0041], [0065]-[0068], [0081]).

Regarding claims 4-6, 65, 66, 84 and 85, Knepper teaches wherein said ad file is selected based at least in part on said media file content; receiving demographic information from said user; and wherein said ad file is selected at least in part based on said user demographic information; wherein said ad file is selected based at least in part on a marketing preference (see [0063]).

Regarding claims 9-14, 67, 70, 86 Knepper teaches wherein said ad file is selected based at least in part on a position of presentation of ad file content with respect to said media file content; based at least in part on a position of presentation of said ad file content with respect to other ad file content; based at least in part on a number of said media files to be presented; based at least in part on other ad files being presented with said media file content; based at least in part on a format of said media file content; (see [0080]-[0085]).

Regarding claims 17, 18, 70, 89, 90, 111, Knepper teaches further comprising making a record of ad files that have been presented to said user; transmitting said ad file presentation records to a provider of said ad files (see [0037], [0041]-[0077]).

Regarding claims 19-23 and 71-73, 91-93, Knepper teaches selecting subsequent ad files based at least in part on said ad file presentation records; receiving a plurality of ad files; said step of receiving input indicative of a user's selection of at least one media file includes receiving a list of media files; and said step of receiving a copy of said media file includes receiving a copy of each media file in said list of media files; wherein said step of resenting said media file content with said ad file content includes arranging said ad files into ad blocks; presenting the content of said media files included in said list; and interrupting the presentation of said media file content with the presentation of the content of said ad blocks at predetermined points;

altering the order of presentation of the content of said media files responsive to input from said user; and altering said predetermined points for presenting said ad block content based on the altered order of presentation of the content of said media files; further comprising: receiving input indicative of said user's desire to re-present the media files included in said list; generating new ad blocks; and presenting said media file content with the content of said new ad blocks (see [0008]-[0014], [0029], [0030], [0041], [0055], [0080]-[0082]).

Regarding claims 24-28, 30, 74 and 94-96, Knepper teaches altering the order of presentation of the content of said media files responsive to input from said user; and altering said ad block content based on the altered order of presentation of the content of said media files; wherein said step of presenting said media file content and said ad file content includes associating an ad requirement with said media file; and presenting sufficient ad file content to satisfy said ad requirement; wherein said ad requirement depends at least in part on the length of said associated media file content; wherein said ad requirement is predetermined for said associated media file; wherein a value indicative of said ad requirement is included in said associated media file; wherein an ad requirement associated with a particular media file is set to indicate that no ad content is required after said particular media file content has been presented with ad file content a predetermined number of times; wherein said ad requirement depends at least in part on a service level associated with said user; (see [0008]-[0014], [0034]-[0037], [0041], [0052], [0084]).

Regarding claims 31-38, 75-77, 97, 98, 114, 115 Knepper teaches said media file content is presented in a first format; and said ad file content is presented in a second format different from said first format; broadcast, said first format is print and the second format is audio;

wherein presenting said media file content and said ad file content includes presenting subsequent pages of said media file content, responsive to user input, while said ad file content is being presented; wherein said media file content and said ad file content are both presented in the same format; wherein said media file content and said ad file content are both presented in audio format; wherein said media file content and said ad file content are both presented in video format; wherein said media file comprises a real time; wherein said media file content and said ad file content are both presented in print format (see [0025], [0037]-[0040], [0049]-[0059], [0092], claims 1-9).

Regarding claim 41, Knepper teaches wherein said media file is received from the provider of said ad file (see [0026]-[0028]);

Regarding claim 44 Knepper teaches receiving updated ad files for use with subsequent presentation of media files (see [0029]-[0030]).

Regarding claims 45-54, 78, 79, 99, 101, 117, 118 and 101, Knepper teaches receiving media file identifiers associated with media files that should no longer be presented; further comprising receiving a new media file identifier associated with a new media file that should be substituted for an existing media file; further comprising associating an identifier with each media file, said identifier being uniquely indicative of a work of authorship contained in said media file; wherein said step of receiving a copy of said media file includes receiving a copy of said media file *in a controlled access format*; decrypting said media file; and providing said decrypted media file to a media player; further comprising restricting access to said decrypted media file; wherein said step of receiving said ad file includes receiving a copy of said ad file in a controlled access format; said step of presenting said media file content and said ad file content

includes dividing said media file into a plurality of segments, and presenting ad file content between said segments (see [0061]-[0070])

Regarding claims 55-57, 80 and 100 Knepper teaches presenting a graphical user interface representing a media player to said user, said interface including: a first tab indicative of a first media type; and a second tab indicative of a second media type; and whereby user selection of said first tab results in the presentation of an active window for the presentation of a media file of said first type, while a media file of said second type is presented in background (see [0038]-[0040]); wherein the first media file is print and second is audio (see [0025], page 10, claims 1-9)

Regarding 58-61, 89, 90, 114, Knepper teaches further comprising making a record of media files that have been presented to said user; transmitting said media file presentation records to a provider of said ad files; further comprising selecting subsequent ad files based at least in part on said media file presentation records; requiring that said ad file content be presented in order to present said media file content; and relaxing the requirement for presenting said ad file for the remainder of a single media presentation session after said ad file has been presented (see [0037], [0041]-[0077], [0080]-[0084]).

Regarding claims 104-106 Knepper teaches providing media files containing copyrighted works; providing ad files; providing a media player operative to combine and present the content of said media files with the content of said ad files; and providing a free license to consumers to present said media files and said ad files with said media player; further comprising authorizing said consumers to reproduce and transfer said media files free of charge; monitoring the presentation of said ad files to said consumers; and conferring a benefit on particular ones of said

consumers based at least in part on the presentation of said ad files to said particular consumers (see [0008]-[0014], [0029], [0030], [0041]).

Regarding claims 107 and 108, Knepper teaches a electronically-readable storage medium having data structure comprising:

a first field containing data identifying a media file (media files downloaded from a server to a client and pre-cached at the client site) (see [0008]).

a second field containing data indicating of an ad requirement associated with said media file (an instruction code downloaded from server to client) see [0009]).

a code for causing an electronic device to present said content of said media file to a user (see [0010]).

No patentable weight is given to the language "said ad requirement being based at least in part on an amount of content of said media file actually presented" and the language "to present said content of said media file to a user, to allow said user to alter the presentation of said media file content, and to monitor said amount of content of said media file actually presented to determine compliance with said ad requirement", which is just an intended use of storing the code in a storage medium. The language further limits the "ad requirement" (associated with a media file), which does not change or further limit the storing of the data structure (i.e., the first filed, second filed and the code).

However Knepper also ad requirement being based at least in part on an amount of content of said media file actually presented; to allowing said user to alter the presentation of said media file content, and monitoring said amount of content of said media file actually presented to determine compliance with said ad requirement (see [0037]-[0040]). Knepper

teaches the client application (at block 805) determines whether the download list contains instruction for including an advertisement in a clip of the episode, if not the client application proceeds to download the first non-advertisement media file for the episode and if an instruction is present in the download list …a user begins play of the episode … typically, a single clip would have an advertisement at its beginning, at its end, both or not all (see [0087]-[0088]. Knepper also teaches the server sending instructions indicating which advertisement media files from among the pre-cached advertisement media files to insert into the entertainment media file at run time, how many advertisement media files to insert, and where to insert them; the instruction file need not specify exactly which advertisement media files to insert; rather, the instruction file can allow the client application to make its own random or pseudo-random selection, subject to any positive and negative associations, for playing back with the entertainment media file (see [0041]).

Regarding claims 109, 110, Knepper teaches wherein said ad file is selected based in part on characteristic of the user (see [0012], [0029]-[0030]-[0040]-[0041]).

Regarding claims 124-127, 129-132 and 134-137, Knepper teaches presenting ad file based on the number of media files presented, number of tracks associated with the media file or number of segments, type of media file (at the beginning or end of every media file, end of every clip or segment as indicated by the instruction set) (see Fig 8b). Knepper also teaches a single clip would have an advertisement at its beginning, at its end, both or not all (see [0087]-[0088].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 7, 8, 29, 39, 40, 42, 43, 112 and 113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knepper further in view of Strietzel (US 6,950,804).

Regarding claims 7 and 8, Strietzel teaches wherein said ad file is selected based at least in part on a geographic location or time of day (see col. 4 lines 14-33, col. 10 lines 1-67, col. 11 lines 1-35, col. 14 lines 59-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the advertisement of Knepper based on location or time of the day in order to provide targeted adverting, as taught in Strietzel.

Regarding claim 29, Strietzel teaches wherein an ad requirement associated with a particular media file is set to indicate that no ad content is required after said particular media file content has been presented with ad file content a predetermined number of times (see col. 4 lines 1-33, col. 10 lines 47-67). Strietzel teaches advertisement could only be added when a user accesses a particular content item for the first time and possibly a few subsequent times or provide the user with an option to purchase the content item. It would have been obvious to one of ordinary skill in the art at the time of the invention to indicate no ad content to be associated with the media file as in Strietzel in order to provide the user with an option to receive the content with or without advertisement associated with it, as taught in Strietzel.

Regarding claims 39 and 112, Strietzel wherein said ad file includes user interactive content (see col. 4 lines 14-33, col. 10 lines 1-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to include interactive content in order to allow the user to receive additional information about the product or to provide an option for the user to make a purchase.

Regarding claims 40, 42, 43 and 113, Strietzel teaches receiving a media file from said user; associating an ad requirement with said media file; and providing said media file to another user; whereby the content of said media file can be presented to said other user with ad file content; wherein at least a portion of said media file is received via a peer-to-peer transfer (see 16 lines 57 to col. 17 line 7). It would have been obvious to one of ordinary skill in the art at the time of the invention to register the user of Knepper to act as a content provider, as in Strietzel, in order to make the content available to other registered users content created by the user or for which the user owns copyrights, as taught in Strietzel.

Claims 15, 16, 68, 69 and 86-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knepper further in view of Eyer et al. (US 6,588,015).

Regarding claims 15, 16, 68, 69, 86-88, Knepper does not specifically teach wherein said step of presenting said ad file content to said user includes ensuring that said ad file content is presented in its entirety include disabling media player playback controls, it is taught in Eyer (see col. 6 lines 50-61, col. 16 lines 46-59, col. 18 lines 48-54). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the control in Knepper as in Eyer for the intended purpose of making sure that the user or viewer listens or views the advertising

message paid by the advertiser. It would have been obvious to one of ordinary skill in the art to also control the volume so that the viewer would listen to the message.

Claims 117-122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knepper further in view of Dunstan et al. (US 7,400,729 B2).

Regarding claims 117-122, Knepper does not specifically teach releasing media file from a secure form using an access key and resecuring said media file using a new access key, it is taught in Dunstan (see col. 1 lines 6-67, col. 6 lines 19 to col. 7 line 13). It would have been obvious to one of ordinary skill in the art at the time of the invention to encrypt the digital content of Knepper, as in Dunstan, in order to secure delivery of the digital content by providing the content to only authorized customers, as taught in Dunstan.

Regarding claim 123, 128 and 133, Knepper does not explicitly teach presenting the ad file based on the amount of time the said media file content is presented to a user. However Examiner takes official notice that it is well known in the art of media broadcasting to establish a time limit for when a commercial should be played or presented. For example advertisement is played every 60 minutes of presenting media program. Therefore, it would have been obvious to one of ordinary skill in the art for the instruction of Knepper to specify presentation of the ad after every 60 minutes or so of playing the media file, in order to maximize the presentation of advertisement.

Response to Arguments

Applicant's arguments with respect to claims 1-137 have been considered but are moot in view of the new ground(s) of rejection.

In Regard to the 112 2nd paragraph rejection regarding claim 3, applicant states that the clear language of Claim 1 covers receiving either one ad file or a plurality of ad files and for example if four ad files are received then at least one ad file is received. Examiner agrees with applicant, however examiner point out if one ad file is received (as claimed in claim 1) the step claimed in claim 3 does not happen. Examiner also points out that it has been held that Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C). No patentable weight is given to claims depending on claim 3. Clams 20-24 and 54 also include language that is considered optional.

Applicant's amendments to the claims overcome the rejection of the 112 rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622